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| NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402 | | | EXAMINER DEXTER, CLARK F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,221

Applicant(s)

STOFFEL, THOMAS

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-17, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 6-11 and 18-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on February 17, 2004 has been received and the references listed thereon have been considered.

Drawings

2. The drawings are objected to because of the following informalities:

In Figure 1, numeral 26 is inaccurate and should be changed to --28--.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3724

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

On page 1, lines 20-25, the sentence is improper since it describes the prior art in both past and present tense, and it seems that in line 22, "secured" should read --secure-- and "increased" should read --increase--, and in line 23, "was" should read --are-- and "had" should read --have-- or the like.

On page 4, line 18, it seems that the recitation -- , which are known in the prior art as shown in Figure 1, -- should be inserted after "28", and the recitation --of the present invention-- should be inserted after "form" or the like for clarity; in line 31, it seems that --(Fig. 1)-- should be inserted after "42" or the like for clarity.

On page 5, line 10, the recitation "in a spaced parallel relative to" is unclear as to what is being described.

On page 6, line 10, the first occurrence of "16" is improper since this numeral is already used to represent a saw blade, and it is suggested to simply delete since a dado blade is not shown; in line 21, the recitation "and thus of saw 14" is unclear as to what is being described.

Appropriate correction is required.

Claim Objections

4. Claims 1-22 are objected to because of the following informalities:

In claim 1, line 2, the recitation "in combination" is not sufficiently clear and appears to be improper, particularly since it is directed to only the insert by virtue of the recitation "with the insert comprising, in combination", and it is not clear as to what "in combination" refers (it is noted that if applicant intends for "in combination" to refer to the insert in combination with the table, it is suggested to change the preamble to read: --In combination, a table of a cutting tool and an insert for receipt in a blade opening of the table of the cutting tool, with the insert comprising: -- or the like; in lines 2-4, the recitation "of a shape corresponding to the blade opening and of a size slightly smaller than and for slideable receipt in the blade opening" is improper since it positively defines the claimed invention in terms of features of the table which is not clearly set forth as part of the claimed invention.

In claim 11, line 1, the recitation "in combination" is not sufficiently clear and appears to be improper since the structure recited thereafter is disclosed as part of the insert.

In claim 12, line 1, the recitation "in combination" is not sufficiently clear and appears to be improper since the structure recited thereafter is disclosed as part of the insert.

In claim 14, line 1, the recitation "in combination" is not sufficiently clear and appears to be improper since the structure recited thereafter is disclosed as part of the

Art Unit: 3724

insert; in line 2, "the plunger opening" is not sufficiently clear as to which one, and it seems that it should be changed to --each of the plunger openings-- or the like.

In claim 16, line 3, "with" appears to be improper, and it seems that it should be changed to --within-- or the like.

In claim 21, line 2, the recitation "in combination" is not sufficiently clear and appears to be improper, particularly since it is directed to only the insert by virtue of the recitation "with the insert comprising, in combination", and it is not clear as to what "in combination" refers; in lines 2-4, the recitation "of a shape corresponding to the blade opening and of a size slightly smaller than and for slideable receipt in the blade opening" is improper since it positively defines the claimed invention in terms of features of the table which is not clearly set forth as part of the claimed invention.

In claim 22, line 1, the recitation "in combination" is not sufficiently clear and appears to be improper since the structure recited thereafter is disclosed as part of the insert; in line 4, "receivings" is improper and it seems that it should be changed to --receiving-- or the like.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3724

6. Claims 12-16, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not provide support for first and second abutting elements *including* means for biasing the abutting element as set forth in claim 12, line 2 and claim 21, line 5. Rather, support is provided for abutting elements in the form of spherical balls 40 and means for biasing the abutting elements in the form of springs 38, wherein these components cooperate with each other and are part of the ball plunger 30.

Claim Rejections - 35 USC § 112, 2nd paragraph

7. Claims 2-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, lines 1-2, the recitation “being adjustably held to the table insert portion by holding screws” is vague and indefinite as to what is being set forth, particularly since it is not clear how the holding screws do not seem to provide any such adjustability.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Niewinski, pn 1,313,107.

Niewinski discloses an insert with every structural limitation that is positively set forth for the insert including:

a table insert portion (e.g., 20) having an outer periphery of a shape corresponding to the blade opening and of a size slightly smaller than and for slideable receipt in the blade opening; and first and second abutting elements (e.g., 24), with each of the first and second abutting elements including means (e.g., 26) for biasing the abutting element away from the outer periphery and adapted to engage the blade opening of the table. It is emphasized that the table of the cutting tool is not disclosed as part of the table insert portion, and further is not positively set forth as part of the claimed invention. It is noted that the recitation “in combination” as presented in the claim refers to the insert only. Thus, the claim is directed to the structure of the insert only and the relationship between the insert and the table is considered a functional recitation of intended use that does not clearly imply any additional structure that can be attributed to the insert.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niewinski, pn 1,313,107 in view of one or both of Nickels, Jr., pn 6,202,311 and Darland, pn 5,497,816.

Niewinski discloses an insert with almost every structural limitation that is positively set forth for the insert as described above and further including first and second plunger openings (e.g., 25) formed in the outer periphery, but lacks first and second housings, with the housings being of a size and shape to be press fit in the plunger openings, with each of the housings receiving one of the abutting elements and the biasing means. However, such housings are old and well known in the art and provide various well known benefits including providing a plunger assembly that provides a consistent depth and thus a consistent operation with respect to the biasing force applied by the spring to the plunger regardless of the depth of the opening in the component into which it is being fitted. Obviously, this facilitates manufacturing since the depth of the openings do not have to be held to tight tolerances. Nickels discloses just one example of a mechanism that includes spring-biased abutting elements that are disposed in a housing (e.g., see Figs. 5-6 and col. 5, lines 6-10). Darland discloses a second example of the use of such a spring-biased mechanism with a housing (e.g.,

see Fig. 5). Therefore, it would have been obvious to one having ordinary skill in the art to provide housings for the abutting elements and springs for the well known benefits including those described above.

12. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wedemeyer et al., pn 5,159,864 in view of one or both of Nickels, Jr., pn 6,202,311 and Darland, pn 5,497,816.

Wedemeyer discloses an insert with almost every structural limitation of the claimed invention including a table insert portion (e.g., 20) having an outer periphery of a shape corresponding to the blade opening and of a size slightly smaller than and for slideable receipt in the blade opening; and first and second abutting elements (e.g., 28). Wedemeyer lacks means for biasing the abutting elements away from the outer periphery and adapted to engage the blade opening of the table, and further lacks first and second housings, with the housings being of a size and shape to be press fit in the plunger openings, with each of the housings receiving one of the abutting elements and the biasing means. However, such spring biased mechanisms are old and well known in the art and provide various well known benefits including facilitating a snug fit while still providing for easy disengagement. Obviously, this facilitates manufacturing since the cooperating dimensions of the interfitted components not have to be held to tight tolerances. Nickels discloses just one example of such a spring-biased mechanism that includes spring-biased abutting elements that are disposed in a housing (e.g., see Figs. 5-6 and col. 5, lines 6-10). Darland discloses a second example of the use of such a spring-biased mechanism (e.g., see Fig. 5). Therefore, it would have been obvious to

Art Unit: 3724

one having ordinary skill in the art to provide housings for the abutting elements and springs for the well known benefits including those described above.

13. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wedemeyer et al., pn 5,159,864 in view of Ocenasek, pn 2,008,673.

Wedemeyer discloses an insert (e.g., 20) with almost every structural limitation of the claimed invention including a table insert portion (e.g., 21) having an outer periphery of a shape corresponding to the blade opening and of a size slightly smaller than and for slideable receipt in the blade opening, with the table insert portion further including an upper surface and a lower surface, with the table insert portion having a passage (e.g. 22) extending from the upper surface through the lower surface; and a kerf insert portion (e.g., 30) formed of cuttable material (e.g., see col. 4, lines 28-32), with the kerf insert portion having a size and shape adapted to fit in the passage, with the kerf insert portion having an upper surface, with the kerf insert portion being insertable into the passage and the kerf insert portion and being adjustably held inside of the passage with the upper surface of the kerf insert portion being planar with the upper surface of the table insert portion.

Wedemeyer lacks the kerf insert portion being insertable by movement perpendicular to the upper surface of the table insert portion (claim 1), and further lacks the kerf insert portion being adjustably held to the table insert portion by holding screws threadably received in at least one of the kerf insert portion and the table insert portion, with the kerf insert portion including holding screw openings for rotatable receipt of the holding screws, and with the table insert portion including threaded, securement

Art Unit: 3724

openings for threadable receipt of the holding screws (claims 2, 3). However, such insert configurations are old and well known in the art and provide various well known benefits including providing a simple configuration that can be easily replaced in the case it becomes damaged. Ocenasek discloses one example of such an insert configuration (e.g., see Figs. 1 and 3; see lines 35-46). Therefore, it would have been obvious to one having ordinary skill in the art to provide the inserts of Wedemeyer with such a configuration for the well known benefits including that described above.

14. Claims 1-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wedemeyer et al., pn 5,159,864 in view of either one of Nadeau, pn 3,386,482 and Dils, pn 6,216,575.

Wedemeyer discloses an insert (e.g., 20) with almost every structural limitation of the claimed invention as described above and further includes with the passage being stepped and including a lip extending from sides of the passage, with the kerf insert portion further having a continuous lower surface parallel to the upper surface, with the kerf insert portion having a thickness between the upper and lower surfaces less than between the upper and lower surfaces of the table insert portion. Wedemeyer lacks the kerf insert portion being adjustably held to the table insert portion by holding screws threadably received in at least one of the kerf insert portion and the table insert portion, with the kerf insert portion including counterbored holding screw openings for rotatable receipt of the holding screws, and with the table insert portion including threaded, securement openings for threadable receipt of the holding screws located in the lip within the passage. However, such a modification would have been obvious to one

Art Unit: 3724

having ordinary skill in the art for the following reasons. Such a modification would include simplifying the configuration by replacing the dovetail groove configuration at the sides of the recess and the kerf insert portion with simple conventional perpendicular walls and providing a screw at one or both ends of the kerf insert portion 30 to fasten it in place to the table insert portion 21 in a conventional manner. It is further noted that counterbored screws, as is known in the art, would be preferred to provide the fastening without obstructing movement of the workpiece past the inserts. Nadeau and Dils each provide an example of such conventional insert fastening structure, which is used to fasten the table insert in place. Therefore, it would have been obvious to one having ordinary skill in the art to fasten the kerf insert portion 30 of Wedemeyer to the table insert portion 21 of Wedemeyer in a conventional manner such as that described above for various well known benefits including simplifying manufacturing, particularly through elimination of the dovetail groove configuration.

Allowable Subject Matter

15. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 6-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims (it is noted that claims 12-16, which depend from claim 11 are rejected under 35 USC 112, 1st paragraph).

Art Unit: 3724


Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
February 21, 2006